

REMARKS

Claims 1-9 were pending in this application. Applicants have canceled claims 2-9, without prejudice to Applicants' right to pursue the subject matter of the canceled claims in related applications. Applicants have amended claim 1 and added new claims 10-35 to more particularly point out and distinctly claim what Applicants regard as their invention. For example, Applicants have amended claim 1 to recite that the composition comprises an extract of *Inula britannica*. Support for the amendment to claim 1 can be found in the specification as filed, see, *e.g.*, page 2, lines 13-15, page 2, lines 19-24, and page 6, lines 20-22 of the specification.

New claim 10 recites a method for preventing cancer by inducing Bcl-2 phosphorylation in an animal, the method comprising administering to the animal a composition comprising an extract of *Inula britannica* in an amount sufficient to induce said phosphorylation to prevent said cancer. Support for this claim can be found in specification as filed, see, *e.g.*, page 2, lines 13-15, page 2, lines 19-24, page 6, lines 20-22 and page 6, lines 26-27 of the specification. New claims 11-14 specify that the extract comprises 1-*O*-acetylbritannilactone or 1,6-*O-O*-diacetylbritannilactone. Support for these claims can be found in the specification as filed, see, *e.g.*, page 2, lines 19-22 and page 6, lines 20-22 of the specification. New claims 15 and 16 specify that the animal treated or prevented is a human. Support for these claims can be found in the specification as filed, see, *e.g.*, page 6, lines 23-25 of the specification. New claims 17-22 specify the type of cancer treated or prevented. Support for these claims can be found in the specification as filed, see, *e.g.*, page 3, line 3 to page 6, line 4. New claims 23 and 24 specify that the composition be administered as a dietary supplement and new claims 25-35 specify the amount of the composition that is administered to a human. Support for claims 23-35 can found in the specification as filed. See, *e.g.*, page 2, lines 22-24 and page 6, lines 20-25 of the specification for support for claims 23-25. Support for claims 25-35 can be found, *e.g.*, at page 4, line 18 to page 5, line 14 of the specification. New claim 36 specifies that the extract is from the floral parts of the *Inula britannica*. Support for this claim can be found, *e.g.*, at page 2, lines 25-26 of the specification.

As discussed above, the amendments and new claims are fully supported by the specification of the present application and do not constitute new matter. Upon entry of this Amendment, claims 1 and 10-36 will be pending in this application.

Entry of the foregoing amendments and consideration of these remarks are respectfully requested.

**The Rejection Under 35 U.S.C. § 102
Should Be Withdrawn**

Claims 1-9 are rejected under 35 U.S.C. § 102(b) as anticipated by DE 198 14 404 A. The Examiner contends that DE 198 14 404 A teaches a method for treating cancer by inducing phosphorylation. For the reasons discussed below, this rejection cannot stand and should be withdrawn.

The legal test for anticipation under 35 U.S.C. § 102 requires that each and every element of the claimed invention be disclosed in a prior art reference in a manner sufficient to enable one skilled in the art to reduce the invention to practice, thus placing the public in possession of the invention. W.L. Gore Associates v. Garlock, Inc., 721 F.2d 1540, 1554 (Fed. Cir. 1983); In re Donohue, 766 F.2d 531 (Fed. Cir. 1985).

DE 198 14 404 A describes the use of an extract of Giersch (*Aegopodium podagraria* L.) alone or in combination with an extract of Alant (*Inula helenium* L.) and/or an extract of Cystus (*Cistus incanus* L.) for the treatment and/or prevention of malignant tumors. DE 198 14 404 A does not teach or suggest the use of a composition comprising an extract of *Inula britannica* for the prevention or treatment of cancer, much less a composition comprising an extract of *Inula britannica* that comprises the specific sesquiterpene lactones recited in claims 11-14, i.e., 1-O-acetylbritannilactone and 1,6-O-O-diacetylbritannilactone. In addition, DE 198 14 404 A does not teach or suggest the following: (i) treating or preventing cancer in humans, as required by claims 15-35; (ii) administering a composition comprising an extract of *Inula britannica* in an amount sufficient to induce Bcl-2 phosphorylation, as required by claims 1 and 10-36; (iii) administering a composition comprising an extract of *Inula britannica* in an amount that produces at least a fifty percent (50%) decrease in cell viability of specific cells relative to a control, as required by claims 25-35; and (iv) administering a composition comprising an extract of *Inula britannica* as a dietary supplement, as required by claims 23 and 24. Further, contrary to the Examiner's contention, DE 198 14 404 A does not teach or suggest a method for preventing or treating cancer by inducing Bcl-2 phosphorylation. Therefore, since DE 198 14 404 A does not teach each and every limitation of the pending claims, it does not anticipate the pending claims. Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) cannot stand and should be withdrawn.

CONCLUSION

Applicants believe that the present claims meet all the requirements for patentability. Entry of the foregoing amendments and remarks into the file of the application is respectfully requested. Withdrawal of all rejections and consideration of the amended claims are requested.

If any issues remain, the Examiner is urged to telephone the undersigned.

Respectfully submitted,

Date: April 6, 2005

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